

Office Action Summary

Application No.

10/587,257

Applicant(s)

SCHMITT ET AL.

Examiner

KARUNA P. REDDY

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 15-24 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 11, 13, 15-17, 22-24 and 28 is/are rejected.
- 7) ☒ Claim(s) 2-6, 8-10 and 18-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice of allowance sent out. Therefore, this final not mailed.

1. This office action is in response to the amendment filed 5/28/2008. Claim 1 is amended; claims 12, 14 and 25-27 are cancelled; and claim 28 is added. Claims 1-11, 13, 15-24 and 28 are currently pending in the application.
2. Amendment to the specification (page 35, lines 3-17) to correct a typographical error is acknowledged.

Double Patenting

3. Claims 1, 7, 11, 13, 15-17 and 22-24 and 28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 12, 15-19, 21 and 25-30 of copending Application No. 11/547,238 in view of Maruyama et al (US 5, 270, 439).

The rejection is adequately set forth in paragraph 4 of office action mailed 9/11/2007.

Specification

4. The disclosure is objected to because of the following informalities:

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The specification on page 34 (lines 5 and 11) refers to compounds XIVa and XIVb as compounds of formula XIV and formula XIII respectively. However, it appears that compounds XIVa and XIVb should be compounds of formula XIII and formula XIV respectively. Applicant is requested to replace the XIV (page 35, line 5) with XIII, and XIII (page 35, line 11) with XIV.

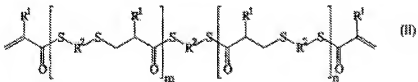
Appropriate correction is required.

Allowable Subject Matter

5. Claims 2-6, 8-10 and 18-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

It is noted that present claims are directed to a mixture for the production of transparent plastics, comprising:

- a) a prepolymer, prepared from compounds of the formula (I) and (II)

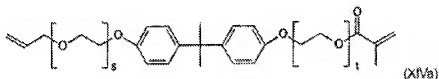


and from alkyl dithiols or from polythiols;

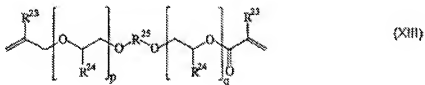
- b) at least one radical polymerizable monomer (A) with at least two methacrylate groups;
c) aromatic vinyl compounds;

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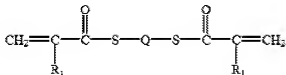
- d) a monomer selected from the group consisting of a monomer capable of free radical polymerization and having at least two terminal olefinic groups whose reactivity differs,
- e) at least one ethylenically unsaturated monomer (B) and mixtures thereof; and
- f) a monomer selected from the group consisting of a monomer capable of free radical polymerization and having at least two terminal olefinic groups whose reactivity differs and monomer is of the formula -



wherein s and t are greater than or equal to zero and the sum s + t is in the range from 1 to 20 or a mixture of monomer of formula (XIVa) and monomer of formula (XIII) –

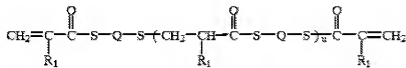


The closest prior art, viz., Smith et al (US 6, 342, 571 B1), Maruyama et al (US 5, 270, 439), Momoda et al (US 6, 698, 883 B2) taken individually or in combination, does not disclose or suggest the polymer composition of present claims. Thus Smith et al teach a polymerizable composition comprising a mixture of thio(meth)acrylate monomers comprising (i) a first thio(meth)acrylate functional monomer of following general formula



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and (ii) a second thio(meth)acrylate functional monomer represented by the general formula II -



(b) an aromatic monomer having at least two vinyl groups, c) a polythiol monomer having at least two thiol groups, d) a monomer capable of free radical polymerization and having at least two methacrylate groups, and e) a monomer capable of free radical polymerization and having at least two terminal olefinic groups whose reactivity differs; Maruyama et al teach a curable composition prepared by previously synthesizing the prepolymer having a polythioether skeleton; and Momoda et al teach curable composition comprising allyl polyethylene glycol methacrylate and is different from the monomer of formula XIVa as recited in the present claims.

Response to Arguments

6. Applicant's arguments, see bridging paragraph page 12-13, filed 5/28/2008, with respect to obviousness-type double patenting rejection, have been fully considered and are persuasive. The obviousness-type double patenting rejection of 1-11, 13 and 15-27 over copending application 10/588,210 has been withdrawn.
7. Applicant's arguments filed 5/28/2008 have been fully considered but they are not persuasive. Specifically, applicant argues that the present application (serial no. 10/587,257) is the first filed application compared to serial no. 11/547,210 (should be

11/547,238). Thus, the provisional double-patenting rejection should be withdrawn. However, applicant's attention is drawn to MPEP 804 [R-5] - III and IV, wherein it specifically mentions that it is necessary to disclaim the terminal part of any patent granted on the application which would extend beyond the application date of each one of the conflicting patents and/or applications, and the office cannot guarantee that two or more applications will have the same issue date. Thus, applicant is requested to file a TD against each of the applications before present claims can be passed to issue.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karuna P Reddy/
Examiner, Art Unit 1796